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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Leon Minassian
Serial No.: 10/054,290
Group Art Unit: 3677
Filed: 11/13/2001
For: Jewelry with Hour of the Day Reminder Mechanism
Examiner: Thomas Ho
Attorney Docket No. 2248.001

BRIEF ON APPEAL

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

This brief is being submitted in triplicate to The Board of Patent Appeals and Interferences in support of the Applicant's appeal from the final rejection of the Examiner, having a mailing date of June 10, 2004, rejecting all pending claims of the application, namely, claims 1, 5, 7, 9, 12, 18, 23 and 25-33.

1. Real Party In Interest

Leon Minassian, the sole inventor and applicant of the patent application is the real party in interest. Neither the invention nor this application has been assigned.

2. Related Appeals and Interferences

No other appeals or interferences are known which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

3. Status of Claims

The pending claims in the present application are claims 1, 5, 7, 9, 12, 18, 23 and 25-33 and all of those claims were finally rejected by the Examiner in an Office Action having a mailing date of June 10, 2004. All of the claims are the subject of this appeal.

Claims 2-4, 6, 8, 10-11, 13-17, 19-22, 24 and 34-40 have been previously canceled.

4. Status of Amendments

This is a statement of the status of an Amendment under Rule 1.116, i.e., filed subsequent to the Examiner's issuance of a final rejection. In response to the Office Action bearing a mailing date of June 10, 2004 which finally rejected the claims, Applicant has simultaneously filed an Amendment pursuant to Rule 116. The changes to the claims sought to be made by the Amendment under Rule 116 are merely to have the claims read more clearly. The changes are not substantive but, rather, merely address minor grammatical issues. It is anticipated that the Examiner will continue to maintain his rejection of the claims, even with the minor changes. Thus, there still appears to be a need for this Appeal. The changes were briefly discussed in a telephone interview with the Examiner. The Examiner did not change his position on finally rejecting the claims, even with the minor changes but, rather, indicated that the rejection would be maintained based on the same prior art. Attached hereto is the Rule 116 Amendment which

sets forth the claims sought for review as a consequence of this appeal.

The Examiner has not yet acted on the claims amended by the Rule 116 Amendment. Nevertheless, based on the Examiner's prior basis for rejecting the claims, the Examiner is anticipated to maintain the rejection of all claims.

5. Summary of Invention

Applicant's invention relates to an attractive article of jewelry, specifically a bracelet made of metal and gems or stones. The bracelet serves a first function of aesthetic adornment, as any article of jewelry, and also serves to remind the wearer of the precise hour(s) of the day for the occurrence of an event(s). See Specification of the patent application ("S"), page ("p") 9, lines ("l") 7 - 8. According to the specification, as set forth in the claims, the bracelet comprises a set of primary links (elements 12 of Fig. 1) which are collectively provided with a set of sequential hour of the day indicators (such as the Roman numerals in Fig. 1), such that there is a visually distinct hour of the day indicator associated with each primary link. Thus, the wearer, by observing the hour of the day indicators can determine what hour of the day (for example, 3 o'clock) is associated with a specific primary link. All hours of the day are sequentially provided, one for each primary link, to form a sequential set of primary links into a bracelet. Again, the primary links are provided with a sequential set of hour of the day indicators, one distinct (or visually unique) indicator for each primary link for visually indicating the hour of the day associated with that primary link. This is recited in the claimed invention.

Applicant's invention, as embodied in claim 1, further recites a set of connecting links (elements 13 of Fig. 2) being spaced between the primary links and together with the primary

links forming the bracelet. The second independent claim, Claim 23, does not recite the presence of connecting links. However, applicant's invention, as embodied in claim 23, in contrast to claim 1, recites that each primary link comprises an analog watch face design. In any event, not to be lost in this brief description of the invention, more fully taught in the detailed specification, is the provision of the distinct (or visually unique) hour of the day indicators for the primary links. The primary links, formed into a bracelet (with connecting links as set forth in Claim 1 or with analog watch face designs on the primary links as set forth in claim 23) are provided with a set of sequential hour of the day indicators, a distinct indicator for each primary link for visually indicating the hour of the day associated with that primary link.

Thus, according to the preferred embodiment, a set of the primary links are provided (with spaced connecting links to form a bracelet as set forth in claim 1) and the Roman numerals I through XXIV are provided such that a single Roman numeral, e.g., VII, is associated with a single primary link (the seventh). Yet, all primary links are provided with a visually unique or distinct hour of the day indicator to provide a set of sequential hours of the day indicators, i.e., in the preferred embodiment, primary links and connecting links connected into a bracelet.

Applicant's invention, also as claimed, teaches two or more marker faces (claim 1), elements 38 of Fig 1 (claim 23 refers to them as "colored stones"), provided to a rotatable knob (elements 37 of Fig. 2) or, in the case of claim 23-- a rotatable rosette. The recited two or more visually distinct marker faces (of claim 1; recited as "two or more different colored stones of claim 23) are turnable by the wearer of the bracelet, as the bracelet is worn, to present a selected and distinct marker face of the turnable knob (or colored stone of the rotatable rosette as set forth in claim 23) to visually distinguish and thus indicate to the wearer which primary link, and thus

which hour of the day, an event needs to be remembered since each primary link is associated with a distinct or visually unique hour of the day indicator.

So, for example, if the wearer needs to remember during the course of her day to pick up her children from day care at 5 p.m., then, when she first dons the bracelet in the morning, she will rotate the “red” marker face (indicating a high level of priority or importance) on the XVII primary link (using military time) to remember that event later in the day. As the day progresses, she is constantly reminded that there is an important event to be remembered at 5 p.m., because the red marker face is visible on the XVII link. Recognize that two or more visually distinct marker faces (as claimed) for the rotatable knob means that, in this example, the knob has four faces and, for example, three can be white diamonds and the fourth face provided with a red ruby or two can be diamonds and one red ruby and one blue sapphire (to be used in the case of a lower priority event to be remembered). Thus, if all of the other marker faces associated with the other (non XVII) primary links outwardly display the white diamond marker faces and the XVII primary link, as determined by the distinct one of the visual set of hour of the day indicators for the seventeenth link, displays during the day a red ruby, in visually and color contrast to the other primary links and marker faces of the rotatable knobs, the wearer will be constantly reminded of the time of day for a high priority event, 5:00 p.m. If, in addition, the wearer wants to remember to place a telephone call to her friend at 3 p.m., again, when she first dons the bracelet she can rotate the red face of the rotatable knob to display another red ruby face for the primary link which is associated with the XV link (3 p.m.). If, for example, the marker faces of the rotatable knobs are provided with four faces, two white diamond faces, a red ruby face, and a blue sapphire face, the user/wearer can selectively rotate the knob of the XV link to display the blue

marker face desired to visually contrast that link with the other non-event primary links and to provide a lower level of priority of importance to the remembered event for the XV link, i.e., the phone call to the friend. Picking up one's children at day care is considered more important to remember than calling one's friend but both events are desirably remembered during the course of the day. Thus, in the above example, the marker face for the XV primary link (3 o'clock in the afternoon) can be turned to display the blue sapphire color while the red ruby marker face of the XVII (5 o'clock) primary link rotated to display the red ruby marker face. In this manner, later in the day, while at work or at play, the wearer will not only be wearing highly attractive jewelry comprised of primary and connecting links with stones or colored gems but will be personally visually reminded of certain prioritized events throughout the hours of the day. Those hours of the day, for which no event needs to be remembered may maintain, for example, the outward display of the white diamond marker face on the rotatable knob.

In the case of claim 23, the primary links are provided with analog watch faces to visually indicate to the wearer the time/hour of the day associated with each primary link. Here, however, the "rotatable knob and two or more marker faces" language of claim 1 is replaced with "a rotatable rosette" with "two or more colored stones". The manner of use of this embodiment is the same as that of the prior described embodiment and is believed to be evident from the above description.

6. Issues

A. Whether the Examiner properly rejected claims 1, 5, 9, 12, 18, 23, and 26-33 under U.S.C. §103(a) as being unpatentable over the prior art US patent of Newman, US 3,217,514

when combined with the teachings of Ebara US 5,787,731 and Mariano US 2,322,461. Three are only two independent claims in the present application, namely claims 1 and 23.

B. Whether the Examiner properly rejected dependent claims 7 and 25 (depending from claims 1 and 23, respectively) under U.S.C. §103(a) as being unpatentable over the prior art US patent of Newman, US 3,217,514 when combined with the teachings of Ebara US 5,787,731, Mariano US 2,322,461 and Warren US 6,260,383. The limitations provided by these dependent claims relate to providing the bracelet with both Roman numerals for identifying the hours of the day for the primary links and analog watch faces as well.

7. Grouping of Claims

1. The rejections under 35 U.S.C. §103(a) of claims 1, 5, 9, 12, 18, 23, 26-28 and 29-33 as being unpatentable over Newman, US 3, 217,514; in view of Ebara, US 5,787,731; and further in view of Mariano, US 2,322,461, stand or fall together.

2. The rejections under 35 U.S.C. §103(a) of claims 7 and 25 as being unpatentable over Newman, US 3, 217,514; in view of Ebara, US 5,787,731; and further in view of Mariano, US 2,322,461; and further in view of Warren US 6,260,383, stand or fall together.

8. Argument

Procedural Background

In the first substantive Office Action, dated February 11, 2003, the first examiner, Andrea Chop, found allowable subject matter. Applicant responded to the February 11, 2003 Office Action by amending and canceling claims and by submitting remarks explaining why the prior art

did not teach the claimed invention. Broader claims were not submitted. Examiner Chop was then replaced by a different Examiner, Thomas Ho, who rejected all of the pending claims after citing new references of Newman and Warren in an Office Action, dated November 19, 2003. Applicant responded to the November 19, 2003 Office Action by again amending and canceling more claims and by submitting additional remarks explaining why the old and the newly cited prior art still did not teach the claimed invention. Examiner Ho, in the Final Office action, dated June 10, 2004, rejected Applicant's arguments and rejected all of the then pending claims under 35 USC 103(a) after citing another new reference, Ebara US 5,787,731, in addition to the earlier prior art references of Newman and Mariano. Applicant's attorney initiated a telephone conference with Examiner Ho. The Examiner's position made little sense. Basically, the Examiner, as set forth in the Final Rejection, seemed to ignore the claimed distinct hour of the day visual indicators on the primary links and determined that that limitation was not structural but, rather, "in the mind of the wearer" and thus not to be considered for patentable weight. Applicant's attorney in a telephone conference disagreed and requested the second opinion of the Examiner's Supervisor. At that "follow-up interview" the Examiner's position was ignored (thankfully since it was so "off the mark") but the Supervisor indicated that she felt the claims were properly rejected for obviousness because, she stated, the art taught the invention. Supported and seemingly pressed by the musings of the Supervisor, who was only called in to discuss the issue of whether the claimed limitation of a distinct hour of the day indicator for each primary link was a) "in the mind of the wearer" and thus not structural and not to be given any patentable significance or weight or b) structure to be entitled to be considered on the issue of patentability, Examiner Ho maintained his rejection of the claims. Applicant strongly disagrees

and this Appeal is thus necessitated. This appeal follows from that final rejection.

Summary of Argument

As a matter of law, Mariano, Newman and Ebara do not render the applicant's invention obvious because they do not teach each and every element of the applicant's claimed invention nor do they render the claimed invention obvious. The prior art, either when individually considered or even if combined together as suggested by the Examiner does not teach primary links having visually distinct hour of the day indicators, together the visual indicators providing a set of sequential hour of the day indicators, one distinct such hour of the day indication for each primary link. Furthermore, there is no teaching or suggestion in the prior art of further providing the primary links with a rotatable knob having two or more visually distinct marker faces which allow the wearer to rotate the knob to display a desired marker face for a selected one or more primary link corresponding to an hour of the day, as appreciated by the hour of the day indicators for the primary links, so as to distinguish the primary links from one another for reminder purposes. Finally, there is no suggestion to a person of reasonable skill in the art to combine the cited references.

The Examiner has truly contorted and distorted the prior art to arrive at a strained, unreasonable and patently wrong conclusion. The Examiner impermissibly used hindsight and Applicant's own teachings to reach the conclusion that the claims are obvious. This practice has been expressly forbidden by the U.S. Court of Appeals for the Federal Circuit. See *Monarch Knitting Machinery Corp. v. Fukuhara Industrial & Trading Co., Ltd.*, 139 F.3d 1009, 45 USPQ2d 1977 (Fed. Cir. 1998) ("Defining the problem in terms of its solution reveals

improper hindsight in the selection of the prior art relevant to obviousness.”); *In re Zurko*, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997) (“To imbue one of ordinary skill in the art with the knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” (citation omitted)). In view of the foregoing, the pending claims recite patentable subject matter and the Examiner’s rejection should be reversed. A detailed analysis of why the Examiner’s rejection of the claims is improper follows.

A. The Rejection of Claims 1, 5, 9, 12, 18, 23, and 26-33 under 35 U.S.C. § 103(a) was Improper - The Rejection Should be Reversed

Specifically, the Examiner rejected Claims 1 and certain of its dependent claims, 5, 9, 12, 18 and independent claim 23 and certain of its dependent claims, 26- 33 under 35 USC 103(a) as unpatentable over Newman US 3,217,514, in view of Ebara US 5,787,731, and further in view of the teachings of Mariano US 2,322,461.

As a preliminary matter, as mentioned above, the Examiner took the unreasonable position that the word “distinct” does not necessarily mean that each indicator is different from the others and that “distinct” may also mean “easy to perceive.” Yet, that interpretation is at variance with the inventor’s consistent teachings of the invention as set forth in the specification and claims. The term distinct, as applied to the present invention is crystal clear– it means that the hour of the day associated with one primary link is different from the hour of the day indicator of an adjacent link. Distinct in this context means that, for example, III is not the same

as XII. Relatedly, 12 is not the same as 3. That is what is meant by the term “distinct” and the Examiner’s rejection on this basis is nonsensical and makeweight. To further clarify Claim 1, however, and to avoid this aspect of the Examiner’s rejection being an issue, the claim has been amended under Rule 116, and the word “distinct” has been changed to “unique,” which means that each hour of the day indicator is visually distinct and different from the others.

Claim 1, describes a jewelry item, having structural elements: 1) primary jewelry links, the set of primary links being provided with a set of sequential hour of the day indicators, a distinct (now visually unique) indicator for each link for visually indicating the hour of the day associated with the primary link; 2) connecting links attached to the primary links; and 3) a rotatable knob for each primary link having at least two marker faces, which knob may be turned while the wearer is wearing the jewelry item to selectively present a selected and distinct face of the knob to the wearer (thereby visually distinguishing it from the other knob(s) on other primary link(s). Each knob is associated with a primary link and thus each knob is associated with the hour of the day indicator on a primary link. The structure described in Claim 1 functions to remind the wearer of the jewelry of a specific hour of the day for performing, attending or doing something (remembering an event). The claimed invention is not taught nor suggested by the prior art, either if considered individually or if combined together.

I. Newman Does not Teach Hour of the Day Indicators for the Primary Links or a
Turnable Knob with Marker Faces

The Examiner identified two substantial differences between independent Claim 1 and the teaching of Newman - i.e one relating to the hour of the day “indicator” elements and the second relating to the “knob” elements. The Examiner recognized that Claim 1 recited distinct

indicators (now claimed as visually unique indicators of the hour of the day for each primary link). The Examiner also seems to have appreciated that the claimed turnable knob (with two or more rotatable faces) is claimed as turnable while the bracelet is worn by a wearer. The Examiner appreciated that Newman does not show distinct indicators, one for each primary link, for showing the hour of the day associated with each primary link, the links showing a sequential set of hours of the day indicators and the knob being turnable while the bracelet is worn by the wearer. See last paragraph of page 3 of Office Action.

While Applicant agrees that the two differences cited by the Examiner exist and are not taught nor suggested by Newman, they are also not taught by the other relied-on prior art. In addition, there is no suggestion in the prior art, Newman or the other references, to combine their teachings. Also, there are further differences between Claim 1 and Newman, some of which the Examiner recognized in the telephone conference (with the Supervising Examiner, held following the mailing of the June 10, 2004 Final Office Action).

In the second telephone conference, with the Supervising Examiner being present, she seemed to recognize that Claim 1 recited, as structure, distinct, sequential hour of the day indicators. She seemed to acknowledge, contrary to the Examiner's stated position, that the recited language was structure and not merely "in the mind of the wearer." The language of Claim 1: "a set of primary links which are provided with a set of sequential hour of the day indicators" is structural and should be given full patentable weight. Applicant believes that the Examiner's initial opinion that such language is "purely functional and holds little patentable weight" was retracted in the telephone conference held among the Examiner, Supervising Examiner and the undersigned, following the issuance of the Office Action. However, the

reversal of that basis for rejection is not “of record.”

Newman does not disclose distinct indicators, nor visually unique indicators, each different from each other and certainly does not disclose a set of sequential hour of the day indicators, a distinct indicator for each link to visually indicate the hour of the day associated with said primary links. Newman shows a repeated and same design for each primary link. There is no showing of numerals, whether Arabic or Roman numerals, of an analog watch face, nothing in Newman which suggests to the wearer how to a) visually distinguish each link from another and b) how the links are associated with an hour of the day, with all links providing a sequential set of hour of the day indicators. Newman is painfully deficient. The Examiner’s position that the indication is in the “wearer’s mind” and thus not structure is wrong and needs to be retracted and made of record. This aspect of the claimed invention is not a figment of the wearer’s mind, but it is clear recited structure.

Furthermore, the application recites as part of its structure that the turnable or rotatable knob has two or more visually distinct marker faces which may be selectively turned, while being worn, to become a reminder mechanism in association with a primary link having an hour of the day indicator. This, too, is not taught by the prior art. Newman does not disclose such a structure and the prior art does not supply the missing structure nor a reason to combine the teachings of the prior art.

II. Mariano Does not Teach A Sequential Set of Hour of the Day Indicators or A Turnable Knob with Marker Faces and There is No Suggestion to Combine the Art of Newman and Mariano

The Examiner relies upon Mariano for its stated teaching that each link can have a distinct indicator. Mariano teaches a bracelet with a day and date of week and day of month

“calendar” indicators. The Examiner stated that it would have been obvious to one of ordinary skill in the art to modify the indicators of Newman (which Applicant asserts are not present) to be distinct on each link, as in Mariano. Yet, Newman only shows the same engraved-like design, the same for each link, none of which are suggested as indicators of the hour of the day. Again, hindsight is to be avoided.

For two independent reasons, Applicant respectfully disagrees with the Examiner’s position. First, even assuming *arguendo*, that it would have been obvious to one of ordinary skill in the art to modify the identical link to link engraved design of Newman to distinct designs on each link as in Mariano (which is vigorously denied) the indicators of Mariano are not a sequential set of hours of the day indicators and there is no turnable knob, with two or more marker faces which serves to visually distinguish one link, associated with an hour of the day, from other links. The flippable plate of Newman is not a turnable knob and cannot be rotated while the wearer wears the same. This distinction is also recited as a limitation in the claimed invention. The claimed visually unique indicators of the recited invention provide “a set of sequential hour of the day indicators.” See Claim 1. The indicators of Mariano are day of the week indicators and do not indicate the hours of the day. Who would have even considered the combination of Newman and Mariano, except one possessed with the teachings of the claimed invention of the present application. The Examiner’s position is unsustainable and should be reversed.

The Mariano device would not help any working woman remember an important event during her work day. Only with 20-20 hindsight is Mariano modified with hour of the day indicators but even there, the prior art fails to teach a rotatable knob with two or more distinct

marker faces to visually distinguish primary links (corresponding to the hours of the day) from one another. Absent Applicant's claimed invention, there is no suggestion in the art to combine these teachings to arrive at the claimed invention. The Examiner has engaged in 20-20 impermissible hindsight.

Newman, even in view of Mariano, does not provide the missing recited elements. There is no prior art reference to the applicant's claimed element of "a set of sequential hour of the day indicators." Having a monthly calender as prior art does not teach a wrist watch. Yet, that is the Examiner's apparent position. As a matter of law, Mariano, Newman and Ebara (Ebara, discussed below, has nothing to do with a set of sequential hour of the day indicators) can not render the applicant's invention obvious because, even assuming one of skill would have a) considered the combination and b) have seen the manner of combining the references, they do not teach each and every element of the applicant's claimed invention. Mariano, Ebara and Newman do not teach primary links having a sequential set of hour of the day indicators. An application may not be rejected as obvious unless each element is taught by the prior art. As stated in the Manual of Patent Examining Procedure (8th Ed., May 2004 Revision), §2143.03 "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981 (CCPA 1974). The prior art relied on by the Examiner is deficient.

It is respectfully submitted that the cited references of Newman, Mariano and Ebara do not disclose "a set of primary links which are provided with a set of sequential hour of the day indicators" nor is there a teaching of a rotatable or turnable knob with two or more marker faces. It is submitted that Claim 1 and the claims that depend therefrom should be allowed.

Mariano does not teach hour of the day indicators. There is nothing in Mariano that teaches or suggests any reason to have an article of jewelry comprised of a set of primary links provided with a set of hour of the day indicators, one such indicator associated with each link. Mariano teaches that an article of jewelry comprised of two bands may serve as a yearly calendar to indicate the day and/or date of a month. The calendar teaching of Mariano is distinct from the Applicant's invention that discloses many structural elements neither taught nor suggested by Mariano. The similarities of the Mariano teaching only relate to wearable articles intended to remind their wearer's of an event. However, the manner of carrying out the respective concepts is structurally quite different. Mariano does not teach a rotatable knob having two or more marker faces for each primary link to visually distinguish it from other links. Indeed, Mariano, to the extent its teaching is stretched, shows two faces which are the links themselves. There is no teaching of the claimed invention nor is there a teaching in Mariano or Newman of the advisability of combining their respective teachings.

A clock that indicates the time of a day is certainly distinct from a calendar that indicates the day of a week. Just as a calendar does not teach the hour of a day, Mariano does not teach the use of hour of the day indicators, associated with primary links, one for each such link and a turnable knob with two or more marker faces, distinct from the links themselves, for visually distinguishing the primary link for which an event is intended to be remembered.

Alternatively, there is no suggestion to a person of reasonable skill in the art to combine the cited references. First, there is no suggestion to a person of reasonable skill in the art to combine the teachings of Mariano with Newman. Mariano teaches three loops, each loop having a series of beads with the loops moveable relative to each other. One loop has a series of beads

having displayed thereon the name of a day of the week, as Monday, Tuesday, etc. A second loop has a series of 31 beads having displayed thereon the numerals 1 to 31 to representing the days of the month. A third loop has a series of beads with the names of the months. The loops and beads may be adjusted so a specific calendar date may be displayed.

It would not have been obvious to one of ordinary skill in the art to modify the indicators of Newman (not even present to Applicant's understanding of Newman, and certainly not visually distinct nor visually unique) to be distinct (i.e., visually different from each other) on each primary link as in Mariano and then to change those indicators to reflect a sequential set of hours of the day and, further, to provide, as separate claimed elements from the links, rotatable knobs with two or more distinct marker faces. Maybe, one would have considered replacing the rotatable plates of Newman with the links of the months of the year, days of the week and dates of Mariano, but that still does not teach the claimed invention—primary links, provided with visually unique indicators so as to provide a sequential set of hours of the day, and a separate rotatable knob for each such link having two or more marker faces so that each primary link can be visually distinguished from others and the knob, rotatable while the wearer is wearing the bracelet, much like the knob of a watch, provides a reminder of an event corresponding to an hour of the day. All links shown in Newman are the same. No rotatable knob is shown in Newman or in Mariano with two or more marker faces. The entire rejection by the Examiner is a fiction and the rejection cannot be sustained.

In contrast to Newman, the primary links in applicant's invention and their hour of the day indications are discernable to the wearer of the jewelry so that the wearer can see the set of hour of the day indicators and recognize which of the primary links corresponds to each of the

hours of the day. In the instant application, a separate claimed element, a “rotatable or turnable knob,” is provided, which is distinct from the primary links themselves. The knob has different (at least two) marking faces, which serve as indicators of which primary link(s) are visually different from the other primary links. The “knob” is rotatable to allow different marking faces to be associated with the primary links to remind the wearer of the jewelry of an event to be remembered, the event being associated with the hour of the day corresponding to that primary link which is provided with a visually distinct and visually unique hour of the day indicator, with all primary links providing, along with the indicators, a sequential set of hours of the day. The invention claimed is patentable and not taught by the references..

Newman teaches a centrally positioned ornamental or plate-like member (25) having two planar faces, which member has a pivotal mounting within a central opening 13 in the ornamental body part 12 of a link 11. Ornamental body part 12 provides support to house the ornamental plate member (25). Thus, Newman teaches an ornamental member or link with changing faces in an article of jewelry which may be converted to display one ornamental face or another ornamental face to provide a new “look” to the jewelry item. Col. 1, l. 13 -15. There is no reason suggested in Newman as to why the surrounding ornamental body part 12 (even assuming for this argument that the flippable plate is a knob, which it isn’t) would be modified to provide visual indicators as in Mariano of the days of the week. Then, of course, the faces have to be modified into sequential hours of the day and, further, a separate knob, i.e., separate from the primary links must be provided to the links with two or more marker faces for identifying which of the primary links is to be remembered for an event during the course of a day. The focus of the viewer’s attention is on the structured, central ornamental plate member 25 and not on the ornamental

body part 12, which merely supports the central ornamental member 25.

The Examiner reasoned that ornamental body part 12 of Newman was the indicator of the applicant's primary link and that the ornamental plate member 25 of Newman was the "rotatable knob" of applicant's claimed invention. See page 3 of Office Action. The Examiner thus suggested using the indicator of Mariano to modify the ornamental body part 12 of Newman. Why would one of ordinary skill do that? Where is the suggestion to do that? Absent Applicant's invention, who would think of doing so?

However, the ornamental body parts 12 in Newman are identical to one another. They provide no visual information. This is very different from the primary links of the claimed invention having hour of the day visually, unique indicators, one such indicator associated with each primary link to provide the claimed sequential set of hour of the day primary links..

The art of Newman teaches away from the claimed invention by teaching that its ornamental supports 12 are identical. Furthermore, ornamental plate-like member 25 can be changed without any reference to its ornamental body part 12. It would not have been obvious to one skilled in the art to modify the indicators of Newman (all identical) to be distinct on each link as in Mariano, because in Newman, the significant feature is that the ornamental member 25 has a flippable face that may be changed to provide a different ornamental face for view. There is no suggestion in Newman that the ornamental body part 12 should be an indicator of time or an indicator of any fact. To a person of ordinary skill in the art, reading Newman (s)he would have no reason to modify the ornamental body part 12, because the focus of the teaching in Newman is to provide for a central ornamental member 25 whose decoration can be changed to provide different "looks" to the jewelry item.

A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be led in a direction divergent from the path that was taken by the applicant. Tec Air, Inc. v. Denso Mfg. Mich. Inc., 192 F.3d 1353 (Fed. Cir. 1999). Where, as here, a reference teaches away from its combination with another source, there is no suggestion to combine the references. Id.

Similarly, the identical links provided by Newman teaches away from using visually distinct links. Relatedly, the reversible beads of Mariano teach away from applicant's invention, too. Applicant's set of primary links have a set of sequential hour of the day indicators that are not reversible, in contrast to the changing beads of Mariano.

III. Newman, in View of Mariano and Ebara Does Not Teach the Claimed Invention

The Examiner relies upon Ebara for its teaching of a jewelry knob that is turnable while the bracelet is worn by a wearer. A standard watch knob shows a rotatable knob in an article of jewelry. However, Ebara does not teach using a rotatable knob, with two or more distinct faces, for visually identifying a primary link in a bracelet for facilitating the reminder of the wearer of an hour of the day for an event to be remembered. This cut and paste of elements, even those components in the jewelry class, does not teach the claimed invention and is nowhere, nohow, suggested by the teachings. Again, this is the Examiner's imagination at work, using the inventor's own teaching as a blueprint! There is no suggestion in any of the prior art for such a combination of elements. The claimed rotatable knob with two or more marker faces and its ability to be rotated/turned while wearing the bracelet is significant since the claimed invention is meant to be a reminder mechanism which can be easily, conveniently and quickly changed for new events to be remembered, without the necessity of the bracelet being removed. No

discomfort occurs by turning the knob of the claimed invention whereas the Mariano and Newman devices will be uncomfortable to the wearer, when the knobs are sought to be changed. Ebara is a new reference, first cited in the present Office Action, and therefore, Applicant has not previously addressed Ebara. Ebara has nothing to do with indicating an hour of the day for an event nor for visually distinguishing one link of a bracelet from another. The Examiner refers to Ebara as disclosing an ornament used on jewelry with a rotatable bearing, similar to that of Newman. The teaching of Ebara does not provide the missing elements of the claimed invention nor even the concept of combining the references.

While the Examiner uses the same word “knob” to describe the “knob” element in the application and the “knob” elements in Ebara and Newman, it is apparent that in applicant’s invention the “knob” is truly a knob and not a rotatable bearing or plate. The suggestion by the Examiner that the plate of Newman is a knob and the bearing of Ebara is also a knob belies common sense. In ordinary parlance, a knob is a round headed device which is turnable by relative movement of a forefinger along the axis of a thumb, with the knob therebetween. This is not the manner of changing the orientation of the plate of Newman nor the bearing of Ebara. Those devices do not show knobs! The prior art Ebara “knob” cannot anticipate the “knob” in the application because these parts do not have the same structure and do not function in the same way. Applied Medical Resources Corp. v. United States Surgical Corp., 147 F.3d 1374 (Fed. Cir. 1998).

The Ebara “knob” is, as stated by the Examiner, similar to that of Newman (element 25 in Newman). Apparently, the Examiner only relies upon Ebara to evidence that a “knob” in the jewelry art exists and a knob can be turnable while a bracelet is worn by a wearer. Whether or not

the “knob” of Ebara may be turned when worn by the user, even if the “knob” of Newman was modified to the “knob” of Ebara to “obtain a rotatable knob in an ornament,” there is no teaching in Ebara or Newman that their “knobs” are to be turned to present a face to be associated with the different hour of the day indicators on each primary link to distinguish the same from other primary links which are provided with visually unique hour of the day indicators. In Ebara and Newman, there are no indicators of hour of the day on any primary link.

The claimed “knobs” of applicant’s claimed invention are associated with primary links, one knob for each primary link; the primary link having a visually, unique one of a set of sequential hour of the day indicators associated therewith. Even if the pivotal plate of Newman is considered “a knob” and modified to be the rotatable “knob” of Ebara, the combination of Newman and Ebara would still not teach the structural elements 1) associating the marker face of the knob with 2) a primary link having 3) a unique one of a set of sequential hour of the day indicators on the primary links. The combination of the Newman, Ebara and Mariano references do not teach associating a marker face of a knob with the sequential set of hour of the day indicators on a set of primary links. Thus, elements are missing from the prior art references relied upon by the Examiner that are recited in Claim 1. There is no teaching in the prior art relied upon by the Examiner of a sequential set of hour of the day indicators, one unique hour of the day indicator associated with each primary link. There is also no teaching in the prior art of associating a knob having at least two marker faces with the sequential hour of the day indicators located on each primary links. The “knobs” of Newman and Ebara have nothing to do with a reminder mechanism as set forth in applicant’s claimed invention. The “knob” of applicant’s invention is structured to be a reminder mechanism for an event at a particular hour of the day,

and the prior art does not teach this.

One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. In re Fine, 837 F.2d 1071 (Fed. Cir. 1988).

As held in Grain Processing Corp. v. American Maize Products Corp., 840 F.2d 902 (Fed Cir. 1988):

Care must be taken to avoid hindsight reconstruction by using ‘the [application] in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims. . . ’

It is similarly impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. In re Fritch, 972 F.2d 1260 (Fed. Cir. 1992).

One can not ‘pick and choose among the individual elements of assorted prior art references to recreate the claimed invention,’ but must look for “some teaching or suggestion in the references to support their use in the particular claimed combination.” Symbol Technologies, Inc. v. Opticon, Inc., 935 F.2d 1569 (Fed. Cir. 1991).

Here, there is no teaching or suggestion in the references cited by the Examiner to support the combination of the elements as stated in Claim 1 of Applicant’s invention.

In summary, Newman, Mariano and Ebara, the references relied upon by the Examiner in considering Claim 1 obvious, do not disclose primary links with a sequential set of hour of the day indicators, one visually, unique indicator for each primary link and a rotatable “knob” having two or more marker faces for each primary link. There is no teaching or suggestion of the jewelry reminder bracelet, as set forth in the claims. There is no suggestion in the prior art to combine these references. Thus, it is respectfully maintained that the Examiner improperly

rejected Claim 1 and each of the claims dependent thereon because they are not obvious in view of the prior art.

The Examiner also objected to Claims 1 and 31 because of informalities.

As to Claim 1, the examiner found the term “and/or” to be unclear and suggested replacing the term “said primary links and/or said connecting links” with “at least one of said primary links and said connecting links.” The Examiner’s suggested correction has been made in the amendment to Claim 1 under Rule 116.

Since Claim 1, as amended, is not obvious in view of the prior art, the claims that depend therefrom are likewise not obvious and should be allowed, i.e, Claims 5, 7, 9, 12, 18, 30 and 33.

The Examiner also rejected independent claim 23 as obvious in view of Newman, Mariano and Ebara, the same references upon which the Examiner rejected Claim 1. While the Examiner stated in the Office Action that the limitations “for indicating . . .of the day” are intended use and hold little patentable weight, the claim discloses the structure of: each primary link comprising an analog watch face design and the series of primary links having sequential, hour of the day indicators. As set forth above, neither Newman nor any prior art discloses an analog watch face design or hour of the day indicators for each of the primary links of a bracelet further provided with a rotatable marker element. Neither does Mariano or Ebara make such disclosure. Independent claim 23 is allowable and the Examiner’s rejection ought to be reversed.

The Examiner has essentially rejected both independent claims 1 and 23 on the same grounds. Claims 25, 26, 27, 28, 29 and 32 are dependent on claim 23. For the reasons set forth

above with respect to claim 1, claim 23 and its dependent claims 25, 26, 27, 28, 29 and 32 should be allowed.

Dependent claim 7, similar to dependent claim 25, teaches the use of two separate mechanisms for identifying the primary links, i.e., an analog watch face and Roman numerals. The use of a fail-safe mechanism to reflect the hour of the day for the primary link and the turnable knob (or rosette, in the case of claim 23) is also neither taught nor suggested by the prior art.

As to claim 31, the Examiner found that it improperly depended on canceled claim 11. Claim 31 has been amended to now depend on Claim 1 .

Neither Ebara, Mariano or Newman have the limitations of claim 31.

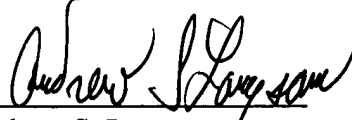
For the reasons set forth above, a reversal of the Examiner's rejection is requested and is fully warranted.

B. The Rejection of Claims 7 and 25 under 35 U.S.C. § 103(a) was Improper

Claims 7 and 25 also recite patentable subject matter. Claim 7 is dependent on claim 1. Claim 25 is dependent on claim 23. Because claims 1 and 23 are patentable, so, too, are claims 7 and 25. Even if, however, claims 1 and 23 are held not-patentable (which Applicant disputes) claims 7 and 25 are themselves patentable and can be rewritten in independent form so as to include the limitations of the base claim. These claims recite both the use of analog watch face designs to indicate the hour of the day associated with the primary links and, in addition, also recite the use of a turnable knob with two or more marker faces (Claim 7 dependent on claim 1) or a rotatable rosette having two or more colored stones (claim 25 dependent on claim 23).

The Board should reverse the Examiner's rejection of all of the claims.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on Sept. 27th, 2004.

September 27 2004



Attachment-Claims on Appeal in Clean Format

The claims on appeal are:

1. An article of jewelry for remembering the hour(s) for an event(s) in the course of a day, comprising:

a set of primary links which are provided with a set of sequential, hour of the day indicators, a visually unique indicator for each link for visually indicating the hour of the day associated with said primary link,

a set of connecting links, said connecting links being spaced between said primary links and together with said primary links forming a bracelet,

at least one of said primary links and said connecting links being provided with at least one rotatable knob having two or more visually different marker faces, said marker faces being turnable by said knob while said bracelet is worn by a wearer so that a selected and different face is viewable to the wearer of said article of jewelry in association with said link

to indicate to the wearer which primary link(s) for the associated hour(s) of the day corresponds to an event(s) to be remembered.

5. An article of jewelry as claimed in Claim 1 wherein said indicators are selected from the group consisting of Roman numerals; Arabic numbers; an analog clock face with markers for the hour of the day; braille markings; and columns of stones with a different stone marking the hour of the day.

7. An article of jewelry as claimed in Claim 1 wherein said set of hour of the day indicators are Roman numerals and said set of connecting links are also provided with a second set of hour of the day indicators in the form of an analog watch face.
9. An article of jewelry as claimed in Claim 1 wherein said at least one rotatable knob comprises four faces, each face having a different colored stone thereon from the other stones on said knob.
12. An article of jewelry as claimed in Claim 1 wherein each of said at least one rotatable knob has four faces, each of which is provided with a colored gem.
18. An article of jewelry as claimed in Claim 1 further comprising a biasing mechanism comprising an axle of square cross-section for said rotatable knob and a resilient spring bearing against a flat surface of said axle for ensuring that said at least one rotatable knob is maintained in place until manually moved into a new orientation.
23. A bracelet for remembering the hour(s) for an event(s) in the course of the day, comprising:
a series of primary links connected to form a bracelet,
each primary link comprising an analog watch face design, the series of primary links having a set of sequential, hour of the day indicators, a visually unique indicator for each

primary link for visually indicating the segmented portion or all of the hours of the day, when all of said links are viewed;

and each primary link being further provided with at least one rotatable rosette having two or more visually different colored stones, such that only one selected stone, at any one time is primarily viewable by the wearer to indicate to the wearer which primary link(s) bearing an hour(s) of the day indicator corresponds to an event(s) to be remembered.

25. A bracelet as claimed in Claim 23 wherein said indicators for said primary links are further provided with Roman numerals to indicate the hour for which an event may occur in a day.
26. A bracelet as claimed in Claim 23 wherein said rotatable rosette has four distinct colored stones to indicate to the wearer two or more levels of importance or types of events to be remembered.
27. A bracelet as claimed in Claim 23 wherein each of said rosettes are held in place by a resilient spring leaf.
28. A bracelet as claimed in Claim 23 wherein said analog watch face design and said indicators are comprised of diamonds and different colored stones.

29. A bracelet as claimed in Claim 23 wherein said primary links are made from precious metal.
30. An article of jewelry as claimed in Claim 1 wherein said primary links are made from precious metal.
31. An article of jewelry as claimed in Claim 1 wherein said primary links are made from precious metal.
32. An article of costume jewelry as claimed in Claim 23.
33. An article of costume jewelry as claimed in Claim 1.